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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,267	05/01/2001	Timothy Merrick Long	169.2039	3091
5514	7590	10/17/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			CHAMPAGNE, DONALD	
		ART UNIT	PAPER NUMBER	
		3622		

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/845,267	LONG, TIMOTHY MERRICK
Examiner	Art Unit	
Donald L. Champagne	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 29 July 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 4-6, 25 and 29-38 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 4-6, 25 and 29-38 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 01 May 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 29 July 2005 have been fully considered but they are not fully persuasive, and some have been made moot by a new basis of rejection. The pertinent arguments are addressed at para. 3 below.

Claim Objections

2. Claims 5, 6 and 36 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Apparatus/system/appliance claims must be distinguishable from the prior art in terms of structure rather than function (MPEP § 2114). The subject claims add no structural limitations.
3. Applicant argues (p. 13, bottom) that the claims comply with 35 USC § 112, fourth para. That is irrelevant: the claims are objected to under 37 CFR 1.75(c), not rejected under 35 USC § 112, fourth para.

Claim Rejections - 35 USC § 102 and 35 USC § 103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4-6, 25, 32, 35 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Angles et al. (US005933811A).
7. Angles et al. teaches (independent claim 4) An information appliance, comprising: a display of a *consumer computer 12* (col. 10 lines 23-24 and 33-38, and col. 11 lines 62-64) incorporating an ad display area (*advertisement insert 56*, col. 12 lines 51-58 and Fig. 4) disposed within a working display area (*electronic page 32*); a store for storing ad information (*advertisement database 70*, col. 13 line 51 and Fig 4); an *electronic page module 32* (col. 12 lines 51-58), which reads on both an advertising application for displaying said advertising information on the advertising display area, and a non-advertising application for execution on the information appliance.
8. No patentable weight was given to the following limitations:
... said advertising display area being associated with an advertising cost charged for displaying advertising information on the advertising display area; (Claim 4 lines 3-7)
... wherein the price of the information appliance depends on a difference between the advertising cost and a cost of manufacturing said information appliance. (Claim 4, last five lines)

Apparatus/system/appliance claims must be distinguishable from the prior art in terms of structure rather than function (MPEP § 2114). These cited limitations of claim 4 are not structural limitations. In addition, claims 5 and 6 were not given patentable weight for the same reason. These limitations could be given patentable weight if they were further limited to "means for" (as in claim 29, for example), or to specify that they are implemented by software. Any such amendments must of course be supported by the original disclosure.

9. Angles et al. teaches (independent claim 25) An information appliance, comprising: a video display having a working display area of a *consumer computer 12* (col. 10 lines 23-24 and 33-38, and col. 11 lines 62-64) incorporating a permanently reserved ad display area (*advertisement insert 56*, col. 12 lines 51-58 and Fig. 4, where *place-holder* reads on "permanently reserved") disposed within a working display area (*electronic page 32*), said reserved display area being adapted to display advertising information independent of the

content provided elsewhere on *electronic page 32* (col. 2 line 59 to col. 3 line 3), and wherein the consumer is sent *unique software which enhances the consumer's Internet browser* (col. 3 lines 25-28), which reads on upgrade software for upgrading said non-advertising application (i.e., browsing the Internet for content) and for providing said advertising information.

10. Angles et al. also teaches at the citations given above claims 32, 35 and 36, where the limitation in claim 35 as to a price of the upgrade software and all of claim 36 could not be given patentable weight for the reasons cited in para. 8 above.
11. Claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being obvious over Angles et al. Angles et al. does not teach that the advertising information is pre-loaded before manufacture into the information appliance or loaded after manufacture using an insertable memory medium. Official notice is taken (MPEP § 2144.03) that both of these approaches for loading software were well known at the time of the instant invention. Because it is obvious to use the familiar, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to either pre-load advertising information before manufacture into the information appliance or load said information after manufacture using an insertable memory medium.
12. Claims 29-31, 37 and 38 are rejected under 35 U.S.C. 103(a) as being obvious over Angles et al. in view of Krishan et al. (US006442529B1).
13. Angles et al. does not teach (independent claim 29) appliance price determination means adapted to determine said price dependent upon a difference between said advertising cost and said manufacturing cost. Inherently, by the mathematics of a difference, said dependency is equivalent to the difference between price dependence on said advertising cost and price dependence on said manufacturing cost. Krishan et al. teaches appliance (*mini-portal device*) price determination means adapted to determine said price dependent upon said advertising cost (*Revenue gained by selling access to users to advertisers*, col. 4 lines 3-5). Because Krishan et al. teaches that this would be attractive to smaller ISPs (col. 2 lines 12-13), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Krishan et al. to those of Angles et al.
14. Neither reference teaches price dependence on said manufacturing cost. Official notice is taken (MPEP § 2144.03) that price of a good commonly depends on its manufacturing cost.

15. Neither reference teaches appliance selling means and advertising selling means. An ordinary telephone reads on such means. Because it is a well known and useful sales tool, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add a telephone/appliance selling means/advertising selling means to the teachings of Krishan et al. and Angles et al.
16. Neither reference explicitly teaches (independent claim 37) means for producing upgrade software. However, since the structure recited in the references is substantially identical to that of the claims, these claimed properties or functions are presumed to be inherent (MPEP § 2112.01). As evidence tending to show inherency, it is noted that the reference does teach upgrade software (para. 9 above), so there must inherently be means for producing upgrade software. The logic for upgrade price determination means is given at para. 13 above with reference to col. 3, lines 38-40 of Krishan et al., and at para. 15 above for means for offering for sale.
17. Neither reference teaches (claim 31) that advertising cost is dependent on time period of display. Official notice is taken (MPEP § 2144.03) that advertising cost is commonly dependent on time period of display.
18. Neither reference teaches (claims 30 and 38) that said price includes a profit. Because a business can be viable only if it makes a profit, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Angles et al. that said upgrade cost includes a profit.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L. Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
20. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

22. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622

12 October 2005